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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,296	06/20/2001	Atsushi Shimizu	15115/003001	2665
22511	7590	11/18/2003	EXAMINER	
ROSENTHAL & OSHA L.L.P. 1221 MCKINNEY AVENUE SUITE 2800 HOUSTON, TX 77010			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,296

Applicant(s)

SHIMIZU, ATSUSHI

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1-22 have been cancelled and Claims 23-36 have been added; therefore, Claims 23-36 are currently pending in application 09/885,296.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 23-28, 35, and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

4. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for

Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

5. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).
6. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

7. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
8. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*.

However, State Street never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

9. Independent Claims 23, 25, 35, and 36 appear to be describing a method that is attempting to sell a direction setting technique for growing personnel. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.
10. As to technological arts recited in the preamble (a method of using a computer..., a computer readable medium storing instructions...), mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.
11. Claims 24 and 26-28 are rejected, as they are dependent on a rejected independent claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 23-36 are rejected under 35 U.S.C. 103(a) as being anticipated by Bechet et

al. (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

13. As per independent Claims 23, 29, and 35, Bechet discloses a method (system, computer readable medium) of forming a fostering plan (Action Plan) for an individual in an organization, the method comprising: (a) receiving information regarding a business target and a business content (Business Context, pg.3), using a first conversion table to convert the information regarding the business target into a business amount per a predetermined time period (Business Scenario, pg.6), using a second conversion table defining a capability type, and a capability amount necessary (required competencies/skills, pg.9) to execute a business pattern (Business Plan, pg.4) comprising the business content and the business amount per the predetermined time period, specifying the business pattern, and converting the specified business pattern into a set of necessary capability amount for respective capability types (Annual Budget, Staffing Plans, and a Long-Range Staffing Strategy, pg.5); (b) receiving information regarding a capability of respective individuals in the organization, and generating capability

information comprising the capability type and the capability amount (Skills Matrix, “Head Contents” – Automated System, pg.3, pg.5); (c) comparing the capability amount in the generated capability information with a first predetermined criterion for the respective capability types, and retrieving, as a strong value, the capability for the capability amount that exceeds the first predetermined criterion for the respective capability types; (d) accumulating the capability amount in the *generated* capability information for respective capability types, comparing the accumulated capability amount with the necessary capability amount for the respective capability types, and retrieving, as a weak value in the organization, the capability for the accumulated capability amount that falls below the necessary capability amount for the respective capability types (deficits in employees with required competencies, pg.5); and (e) forming a fostering plan (Action Plan, pg.3) of a specific individual having the retrieved weak value in the organization as the strong value, *wherein the fostering plan being associated the specific individual with the type of weak capability (redeployment)* (Bechet, Thomas P; Walker, James W, “Aligning Staffing with Business Strategy,” Human Resource Planning, v16n2, pp:1-16, 1993).

14. Bechet fails to expressly disclose outputting the formed fostering plan in a predetermined output form.
15. However, Bechet does disclose using computer-based models (pg.11) to perform business-planning operations to include the calculation of staffing gaps (e.g., shortages or surpluses in required skills or staffing levels, pg. 10), and the output of such a calculation would have been obvious to include with and computer-based operation at the time the

invention was made. Furthermore, it would have been obvious to include the additional business identification/planning/action steps disclosed by Bechet in a computer-based model, as it would simply be a matter of automating a well-known business process.

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting the formed fostering plan in a predetermined output form in the system disclosed by Bechet, for the advantage of providing a method of forming a fostering plan for an individual in an organization, with the ability to more effectively and efficiently process the business data by using computer automation.

17. As per Claims 24 and 30, Bechet discloses wherein the step (a) further comprises specifying a present business pattern and a future business pattern; the step (b) further comprises generating present capability information and future capability information; the step (c) further comprises retrieving, as a first strong value, the first capability for the present capability amount that exceeds the first predetermined criterion, and calculating progress of the capability amount by comparing the present capability information with the future capability information, and retrieving, as a second strong value, the second capability for the progress that exceeds a second predetermined criterion; the step (d) further comprises retrieving a present capability and a future capability as a present weak value and future weak value; and the step (e) further comprises forming the fostering plan including a target value based on the progress of the capability amount for the individual having the present weak value or the future weak value in the organization as the first

strong value or the second strong value (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

18. As per independent Claims 25, 31, and 36, Bechet discloses a method (system, computer readable medium) for selecting an individual to be supplemented for an organization (Recruitment, Redeployment), the method comprising: (a) receiving information regarding a business target and a business content (Business Context, pg.3), using a first conversion table to convert the information regarding the business target into a business amount per a predetermined time period (Business Scenario, pg.6), using a second conversion table defining a capability type, and a capability amount necessary (required competencies/skills, pg.9) to execute a business pattern (Business Plan, pg.4) comprising the business content and the business amount per the predetermined time period, specifying the business pattern, and converting the specified business pattern into a set of necessary capability amount for respective capability types (Annual Budget, Staffing Plans, and a Long-Range Staffing Strategy, pg.5); (b) receiving information regarding a capability of respective individuals in the organization, and generating capability information comprising the capability type and the capability amount (Skills Matrix, "Head Contents" – Automated System, pg.3, pg.5); (c) accumulating the capability amount in the *formed* capability information for respective capability types, comparing the accumulated capability amount with the necessary capability amount for the respective capability types, and retrieving, as a weak value in the organization, the capability for the accumulated capability amount that falls below the necessary capability amount for the respective capability types; and (d) retrieving, using a database storing a

plurality of records regarding a capability type and a capability amount of an individual to be supplemented into the organization, at least one of the record regarding the individual having the capability amount corresponding to the retrieved weak value (Evaluate Current Talent, pg.11; Action Plans – closing gaps with recruiting and movement, pg.12) (Bechet, Thomas P; Walker, James W, “Aligning Staffing with Business Strategy,” Human Resource Planning, v16n2, pp:1-16, 1993).

19. Bechet fails to expressly disclose outputting the formed fostering plan in a predetermined output form.
20. However, as explained above, Bechet does disclose using computer-based models (pg.11) to perform business-planning operations to include the calculation of staffing gaps (e.g., shortages or surpluses in required skills or staffing levels, pg. 10), and the output of such a calculation would have been obvious to include with and computer-based operation at the time the invention was made. Furthermore, it would have been obvious to include the additional business identification/planning/action steps disclosed by Bechet in a computer-based model, as it would simply be a matter of automating a well-known business process.
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included outputting the formed fostering plan in a predetermined output form in the system disclosed by Bechet, for the advantage of providing a method for selecting an individual to be supplemented for an organization, with the ability to more effectively and efficiently process the business data by using computer automation.

22. As per Claims 26 and 32, Bechet discloses comparing the capability amount in the generated capability information with a predetermined criterion, and retrieving as a strong value, the capability for the capability amount that exceeds the predetermined criterion; forming a fostering plan of a specific individual having a weak value in the organization as the strong value; and outputting the formed fostering plan result in a predetermined output form (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).
23. As per Claims 27 and 33, Bechet discloses wherein the step (a) further comprises specifying a present business pattern and a future business pattern; the step (b) further comprises generating present capability information and future capability information; the step (c) further comprises retrieving, as a present weak value and a future weak value, a present capability and a future capability; and the step (d) further comprises retrieving records regarding the respective individuals having the capability amounts respectively corresponding to the retrieved present weak value and the retrieved future weak value (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).
24. As per Claims 28 and 34, Bechet discloses wherein step (c) further comprises holding the accumulated capability amount as a previous accumulated capability amount; the method re-executes the steps (b) and (c) after executing the step (e), and retrieves the progress of the capability in the organization based on the re-accumulated capability amount and the previous accumulated capability amount; and the method further comprises calculating a yield to be billed for the organization based on the progress and outputting a debit note

based on the yield (Bechet, Thomas P; Walker, James W, "Aligning Staffing with Business Strategy," Human Resource Planning, v16n2, pp:1-16, 1993).

Response to Arguments

25. Applicant's arguments filed 8/20/2003, with respect to Claims 1-22, have been considered but are moot in view of the new ground(s) of rejection.
26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-

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0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.


29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

30. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.



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November 14, 2003



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600